

Serial No.: 10/751,544

### REMARKS

The claims in this application are claims 1-23 and 35-39. Claims 24-34 were canceled in a preliminary amendment.

Claims 1-23 and 35-39 have been rejected under the judicially created doctrine of double patenting over the claims of U.S. Patent No. 6,679,836.

The accompanying terminal disclaimer should overcome this rejection, as stated by the Examiner.

Claims 1, 4-7, 12-21, 23 and 36-39 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Belson U.S. 6,468,203 in view of Madden et al. U.S. 6,249,076 (Madden I). This rejection is respectfully traversed.

As the examiner has apparently recognized, to support a rejection for obviousness, motivation must be found in the references to modify or combine their teachings to arrive at the claimed invention. There must be a convincing explanation on the part of the examiner and not just unsupported conclusions. *In re Jones*, 21 USPQ 2d 1941, 1943-44 (Fed. Cir. 1992), *In re Fine*, 5 USPQ 2d 1596, 1598-99, *Ex parte Levengood*, 28 USPQ2d 1300, 1301.

Belson discloses a colonoscope that is guided by electronically controlled actuators. The only specific actuators disclosed in an enabling manner are not electroactive polymer reactors. In a "shotgun" disclosure, the reference recites "or other known ... electromechanical actuator." There is no evidence that electroactive polymeric actuators were considered by patentee.

Madden I discloses electroactive polymeric actuators. However, the only practical application disclosed uses a maximum disclosed number of two actuators to turn a bearing in a mechanical device. There is no suggestion of how the disclosed actuators could be used in greater number in a colonoscope (Belson).

A conclusion of obviousness under 35 U.S.C.103 could only be reached by studying the here claimed invention and combining the disclosures of the references with the application of undue hindsight. That procedure has long been held to be completely improper. See, merely for example, *Akzo N.V. v. U.S. International Trade Commission*,

Serial No.: 10/751,544

1 USPQ2d 1241, 1246 (Fed. Cir. 1987) and MPEP 2142, second paragraph.

The examiner has stated with regard to claim 4 that it is "inherent" that the actuators will be in "tension with each other." An explanation of the Examiner's conclusion is required. It has been held that "a retrospective view of inherency is not a substitute for some teaching or suggestion [to combine the reference teachings]." *In re Newell*, 13 USPQ2d 1248 (Fed. Cir. 1989), *In re Sorrmann* 150 USPQ 449 (Fed. Cir. 1966).

Similar remarks apply to the Examiner's treatment of claim 12. There are many more than two ways in which control signals could be sent to actuators by cable or cables. Furthermore, a conclusion of "design choice" in the absence of reasoning is never appropriate. See, e.g., *In re Lindberg*, 169 USPQ 728, 730 (Fed. Cir. 1971).

Claims 2 and 3 have been rejected under 35 U.S.C. 103 (a) as being unpatentable over Belson in view of Madden I and the Madden et al. (SPIE article, Vol. 3429, pp. 72-83, March 5-8, 2001 Madden II). This rejection is respectfully traversed.

This rejection involves the undue hindsight discussed above, further aggravated by the selection of a specific polymer from many. The above remarks and citation of precedent apply to this rejection.

Claims 10 and 22 have been rejected under 35 U.S.C. 103 (a) as being unpatentable over Belson in view of Madden I and Shan U.S. 5,597,833. This rejection is respectfully traversed.

Shan utilizes strain gauges only to provide a video image. There is no suggestion to utilize that image to control the action of any type of actuator. Thus the undue hindsight previously discussed is still further aggravated, and the use of "bits and pieces" of the references criticized in *Akzo supra*, is even more readily apparent.

Claims 11, 12 and 35 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Belson in view of Madden I and Takayama et al. U.S. 5,624,380 (Takayama). This rejection is respectfully traversed.

The actuators of Takayama are made of "shape memory alloy," which are quite different from the electroactive polymeric actuators of Madden I (and the present claims).

Serial No.: 10/751,544

Thus, incorporating the teachings of Takayama simply multiplies the inappropriate "bits and pieces" selection from the prior art references discussed at length above.

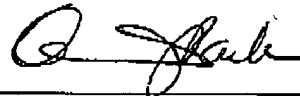
In light of the foregoing remarks, it is believed that the rejections of record have been obviated, and allowance of this application is respectfully solicited.

If a telephone conference would facilitate examination of this application in any way, the examiner is invited to contact applicants' attorney at (908) 518-7700. The Examiner's consideration of this matter is gratefully acknowledged.

An executed Statement Under 3.73(b) and new Power of Attorney document are filed herewith.

Respectfully submitted,

By:



Keum J. Park  
Registration No. 42,059

Attorney for Applicant  
Mayer Fortkort & Williams, PC  
251 North Avenue West, 2<sup>nd</sup> Floor  
Westfield, NJ 07090  
Tel.: 908-518-7700, ext. 7  
Fax: 908-518-7795

#### CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this document, and any document referenced herein, has been transmitted via facsimile to the US Patent and Trademark Office at (703) 872-~~9302~~ on 1/11/05 <sup>9306</sup>.

Debra Rosenbaum  
(Printed Name of Person Faxing Correspondence)

Debra Rosenbaum  
(Signature)